



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

ll

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/342,707	06/29/99	HILL	K 312.104331R0

020457 MM92/0322
ANTONELLI TERRY STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON VA 22209

EXAMINER

HEALY, B

ART UNIT

PAPER NUMBER

2874

DATE MAILED: 03/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/342,707

Applicant(s)

HILL ET AL.

Examiner

Brian M. Healy

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on the amdts. filed 12/23/99 and 2/25/00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 30-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26,28 and 29 is/are allowed.
- 6) ☒ Claim(s) 1,8,9,10,17,19,25 and 41 is/are rejected.
- 7) ☒ Claim(s) 2-7,11-16,18,20-24 and 27 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: Brian Healy

Art Unit: 2874

DETAILED ACTION

Response to Arguments

Applicant's response to the rejection, mailed 12/17/99, along with the new oath or declaration, filed with same, overcomes the rejection made under 35 U.S.C. 251 in the previous office action. However, the amendment, filed on 12/23/99 which seeks to cancel claims 30-40 and 42, is in error because there is no claim 42 in the case. It is thought by the Examiner that Applicant meant to cancel claim 41, but this desire to cancel claim 41 must be positively stated for the record.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 41 is rejected as being incomplete because it is now dependent upon cancelled claim

Art Unit: 2874

3. *Specification*

Applicant is entitled to amend the specification to make reference that the present application is a CIP to copending U.S. Patent Applications No.811,299, now U.S.P. No.5,216,739 and No.656,462, now U.S.P. No.5,104,209. However, if a claim in a CIP application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 U.S.C. 112 in the parent nonprovisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the CIP application. (See MPEP 201.11).

Applicant is also entitled to amend original claims claims 1 and 15 to add language which correct errors of omission which could have been rejectable under 35 U.S.C. 112 par.2.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2874

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1,8,9,10,17,19 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Snitzer et. al., U.S.P. No.5,351,321.

Snitzer et. al. '321 teaches (Figs.1-16) a method of making Bragg gratings in optical fibers and other waveguides comprising the steps of: placing an optical fiber medium 12, which can be made of silica (i.e. silicon dioxide), adjacent and parallel to a silica (i.e. silicon dioxide) phase grating mask 24,27,28 (Note that the striations of the phase mask are orientated orthogonal to the axis of the optical fiber) and applying a collimating light beam through a collimating lens 23 from light source 25 in order to form a Bragg grating (Note Figs.3-13 wherein the phase mask contains striations which can be varied in pitch and intensity) on the photosensitive optical fiber medium 12, which clearly fully meets Applicant's claimed limitations.

It should be noted that Snitzer et. al.'321, which has a filing date of 10/20/92 can be applied to the claims of the present application, which has a filing date of 10/29/92 even though the present application now has earlier parent cases. Since the earlier parent cases do not have disclosure of the claimed silica glass phase grating mask, then Applicant is only entitled to the CIP filing date of 10/29/92. (See MPEP 201.11).

Art Unit: 2874

Allowable Subject Matter

6. Claims 26,28 and 29 are allowed. The claimed features of these claims are not shown or taught by the prior art of record.

7. Claim 2-7,11-16,18,20-24 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any questions concerning this office action should be directed to:

Brian M. Healy

Primary Examiner

Art Unit: 2874

Phone:(703)308-2693


Brian Healy
Primary Examiner